

REMARKS

In the Office Action mailed October 16, 2008, the Office considered claims 1-13. With this Response, Applicants amend claims 1, 6, and 9, cancel claim 4, and add new claims 14-17, leaving claims 1-3 and 5-17 pending and under consideration.

Information Disclosure Statement

The Examiner attaches to the Office Action a Form PTO-1449 from Applicants' IDS filed September 21, 2006, in which the English language Abstract of JP 5-262862 is lined out. The Action states that the lined-out reference was either misidentified or not provided.

In response, Applicants submit that the document was provided, as shown by Applicants' date-stamped mailroom receipt, which is attached hereto. Applicants also respectfully submit that the document was not misidentified. Thus, Applicants submit that the Patent Office misplaced the Abstract and it was therefore not entered into the electronic record for the Examiner's review. Applicants submit herewith a second copy of the Abstract and a new Form PTO-1449 so that the Examiner's consideration of the document can be indicated on the record. No fee is required for this submission, as Applicants are simply providing a second copy because the Patent Office apparently misplaced the first.

Reference to Related Applications

The Office Action states that this application appears to claim subject matter disclosed in a prior application, PCT/JP04/18388, and that a specific reference is required in the first paragraph. In response, Applicants respectfully note that this

application *is* the U.S. national stage application of PCT/JP04/18388, and thus, PCT/JP04/18388 is not a *prior* application, but rather, the *present* application.

Applicants submit that no amendment to the specification is required.

Claim Rejections – 35 U.S.C. § 112, Second Paragraph

The Office Action rejects claims 9-11 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite, in particular, for failing to provide antecedent basis for “(C)” in claim 9.

In response, Applicants note that those elements referring to “(C)” have been removed from claim 9 by amendment, and reintroduced in new claim 15, which depends from new claim 14, which depends from claim 6, in which “(C)” is introduced. Applicants respectfully request withdrawal of the rejection.

Claim Rejections – 35 U.S.C. §§ 102(b) or 103(a)

The Office Action rejects claims 1-3, 5, and 8-11 under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over, JP 2003-020388.

In response, Applicants note that claim 1 has been amended to recite the elements of claim 4. Applicants note that claim 4 was not rejected over JP 2003-020388, and thus, with the present amendment, the rejection is moot.

The Office Action rejects claims 1-5 and 8-11 under 35 U.S.C. § 102(b) as allegedly anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over, JP 2003-020398. The Action asserts that the crystallization

temperature and enthalpy, which are not disclosed by JP 2003-020398, would be assumed to be inherent because the same materials and amounts are allegedly used.

Applicants initially wish to point out that a claimed feature can only be present if it *necessarily* results from the prior art. It is not enough that it might result, under certain circumstances. Thus, to establish that the claimed crystallization temperature and enthalpy are inherently present, the Office must establish that they are necessarily present. Applicants note that crystallization enthalpy ΔH_{cc} depends not only upon the composition, but also upon the method by which the composition is made. Applicants' claimed crystallization enthalpy ΔH_{cc} does not result when all of the polyester resin and polycarbonate is mixed in one step. Applicants also respectfully note that the cited art does not disclose or suggest Applicants' claimed methods, the elements of which are separately claimed in claims 12 and 13.

Applicants note that in JP 2003-020398, the entire amounts of polytrimethylene terephthalate (PTT) and polycarbonate (PC) are molten and kneaded, which corresponds most closely to Applicants' Comparative Example 1, though the formulations are slightly different. Comparative Example 1 is inferior to Examples 1-6 in impact resistance, heat resistance, and rigidity when heated. Applicants respectfully submit that the cited art does not disclose or suggest the claimed crystallization enthalpy ΔH_{cc} , or any of the advantageous features of the end product.

In view of the foregoing remarks, Applicants respectfully submit that JP 2003-020398 does not disclose or suggest Applicants' claimed invention.

The Office Action rejects claims 12 and 13 under 35 U.S.C. § 103 (a) as allegedly obvious over JP 2003-020398, “optionally” in view of Principles of Polymer Processing text (hereinafter “Principles text”). Applicants respectfully disagree with the rejection.

Applicants initially submit that the Action’s reliance in the rejection on Principles Text is not optional, as the Action has admitted that JP 2003-020398 does not disclose blending part of the polycarbonate with the polyester in the initial step, followed by blending the remainder of the polycarbonate. Moreover, Applicants respectfully submit that JP 2003-020398 does not suggest this element of the claimed invention. Thus, JP 2003-020398 alone does not anticipate or render obvious claims 12 and 13.

Applicants respectfully note that the Principles text teaches use of the “masterbatch” style to compositions in which particulate additives, such as carbon black, are added. Principles text teaches that this process is desirable when agglomeration of an additive is a concern and clearly all of the advantages discussed in Principles text relate to distribution of an additive with a tendency to agglomerate. Thus, the Action’s suggestion that Principles text broadly teaches this mixing process to any composition is an overly broad interpretation – the teaching is limited to circumstances in which agglomeration of a particulate additive is sought to be avoided. There is no suggestion at all in Principles text that any advantageous result would be achieved by mixing a composition as recited in claims 12 and 13.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the rejection. In the event that the Office maintains the rejection, Applicants

request that the Office provide a complete copy of Chapter 11 from Principles text. In the absence of the entire Chapter, Applicants are unfairly disadvantaged in being able to fully respond to the Office Action. Indeed, Applicants submit that the rejection is improper for the Action's failure to provide the entire Chapter, and must be withdrawn for at least this reason.

The Office Action rejects claims 1-11 under 35 U.S.C. § 103(a) as allegedly obvious over Galluci (U.S. Patent No. 6,060,538). Applicants respectfully submit that Galluci does not render obvious claims 1-11.

Applicants note that Galluci mixes the entire amounts of polyester resin and polycarbonate in one step. As noted above, Applicants' claimed crystallization enthalpy ΔH_{cc} , or any of the advantageous features of the end product, will not result when the entire amount of polyester resin and polycarbonate are mixed in a single step. Thus, the claimed a crystallization enthalpy ΔH_{cc} would not necessarily be present in the composition of Galluci, and there is nothing in Galluci that would lead one of skill in the art to practice Applicants' methods, which would result in the claimed features.


Indeed, even in its closest embodiments, Galluci's compositions are different from and do not suggest the presently claimed invention. For example, even when PBT is used as the polyester resin, as in the Examples of Galluci, it becomes inferior when heated. (See Comparative Example 2 of the present specification.) Thus, Applicants respectfully submit that Galluci fails to render obvious the presently claimed invention, and respectfully request withdrawal of the rejection.

Conclusion

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of the rejections of record and allowance of the claims. If the Examiner has any questions or wishes to further discuss this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

If there should be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
Tomofumi MAEKAWA



Bruce H. Bernstein
Reg. No. 29,027 42,920

January 15, 2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191